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ECOLAB INC.
840 SIBLEY MEMORIAL HIGHWAY
MENDOTA HEIGHTS, MN 55118

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,621

Applicant(s)

MILLIORN ET AL.

Examiner

Walter B Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The cancellation of claims 1-7, 9, 10, 12-18, 21 and 23 in the Amendment filed July 19, 2004 (Amdt. E) has been acknowledged by Examiner.
2. New claims 29-46 presented in Amdt. E have been received and considered by Examiner.

WITHDRAWN REJECTIONS

3. The 35 U.S.C. 103 rejections of claims 1-7, 9, 10 and 12-14 made of record in paragraphs 6-9 of Paper 15 have been withdrawn due to Applicant's cancellation of claims 1-7, 9, 10 and 12-14 in Amdt. E.
4. The 35 U.S.C. 103 rejection of claims 15-18, 21 and 23 made of record in paragraph 10 of Paper 15 has been withdrawn due to Applicant's cancellation of claims 15-18, 21 and 23 in Amdt. E.

NEW REJECTIONS

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 29, 33, 34, 36 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to claim 29, the recitation "putting the triangular shaped labels" renders the claim indefinite: "putting" the labels where? Did Applicant intend to recite "cutting" (see claim 1 in previous set of claims)? Claim 33 recites the limitation "facing material"; there is insufficient antecedent basis for this limitation in the claim. The term "facing"

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should be amended to "face". Claim 34 recites the limitation "printing"; there is insufficient antecedent basis for this limitation in the claim. Claim 36 recites the limitation "printing the labels"; there is insufficient antecedent basis for this limitation in the claim. In regard to claim 42, the article "the" should be inserted between "from" and "group".

Claim Rejections - 35 USC § 103

7. Claims 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oosterlinck in view of Warther.

In regard to claim 29, Oosterlinck teaches a method and apparatus for converting label base stock 10 to releasably-lined labels, the base stock having a face web 12, a backing liner 16 and adhesive layer 14 in between face web 12 and backing liner 16 (col. 3, lines 27-33, col. 6, lines 46-50 and Figure 1). Oosterlinck teaches that the backing liner 16 includes a silicone coating release layer 18 that allows the backing liner 16 to release from the face web 12 (col. 4, lines 15-20 and Figure 1). Since the labels are releasably lined, the liner is separable from the face material and the adhesive layer. A continuous supply of base stock 10 is fed into the label conversion apparatus where the base stock travels in the direction indicated by the arrows drawn inside rollers 22, 24, 26 and 38 in Figure 2 (col. 3, lines 50-67). The face material and adhesive layer are cut from face web 12 and are imprinted (col. 3, lines 53-58 and 26-30). Oosterlinck teaches the formation of a roll of labels at rewind mandril 28 (col. 6, lines 29-31 and Fig. 2).

In regard to claims 29 and 30, Oosterlinck fails to teach the step of configuring a plurality of triangular shaped labels on the face material in which each label has a first, second and third side wherein the first side of adjacent labels face each other and the second side of adjacent labels face each other such that the third side of each label faces outwardly from the web width.

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In regard to claim 30, Oosterlinck fails to teach adjacent rows of triangular shaped labels positioned parallel to the web direction. However, Warther discloses a modified sheet product 110 that holds triangular-shaped tag elements (items 50A-50X) that are configured such that the first side of adjacent labels face each other and the second side of adjacent labels face each other such that the third side of each label faces outwardly from the web width in order to maximize the number of tag elements which may be provided on a sheet product of a given size (col. 3, lines 33-41 and Figure 3). Warther also discloses adjacent rows of the triangular shaped tags in Figure 3. Therefore, one of ordinary skill in the art would have recognized to have constructed the labels of Oosterlinck in the triangular shaped form of the tags of Warther and to have configured the triangular shaped labels such that the first side of adjacent labels face each other and the second side of adjacent labels face each other such that the third side of each label faces outwardly from the web width in order to maximize the number of elements which may be provided on a sheet product of a given size as taught by Warther.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the labels of Oosterlinck in the triangular shaped form of the tags of Warther and to have configured the triangular shaped labels such that the first side of adjacent labels face each other and the second side of adjacent labels face each other such that the third side of each label faces outwardly from the web width in order to maximize the number of elements which may be provided on a sheet product of a given size as taught by Warther.

In regard to claim 31, Oosterlinck teaches that the face web is made of a flexible material such as paper or plastic (col. 4, lines 6-7). Note that polyester, vinyl, polypropylene and plastic foil are all plastics. In regard to claim 32, Oosterlinck teaches that the adhesive is selected

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according to the intended end use of the label by considering the length of time the label is intended to be affixed to an article and the temperature or other environmental conditions to which the label will be exposed (col. 4, lines 9-14). Thus, each of the four claimed types of adhesive (permanent, removable, water-soluble and cold temperature) are taught by Oosterlinck. In regard to claim 33, Oosterlinck teaches the collection of waste matrix material subsequent to die cutting of the labels (col. 2, lines 41-43). In regard to claim 34, Oosterlinck teaches that a design or other label information is printed on the front surface of the label (col. 5, lines 31-36). Examiner interprets "other label information" to denote text, inter alia.

8. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oosterlinck in view of Warther, and in further view of Kirk, and in further view of admitted prior art of Applicants (specification, page 1, paragraph [0003]).

Oosterlinck and Warther teach the triangular shaped label as discussed above. Oosterlinck and Warther fail to teach that the text printed on the plurality of labels is related to text used in food safety labeling systems and that the text consists of text found in day of the week FIFO food safety labeling systems, text relating to shelf-life/product identification food safety labeling systems and text relating to use by/use first food safety labeling systems. However, Kirk teaches that it is necessary that the container for particular food products include information such as the name of the product, the ingredients of the food product, the batch or lot number of the food product, the expiration date for use of the product and instructions relating to the dispensing and use of the product (col. 1, lines 20-27). Therefore, one of ordinary skill in the art would have recognized to include this food safety information taught by Kirk on the triangular shaped label taught by Oosterlinck and Warther in order to convey necessary food

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safety information, as it is notoriously well known to include food safety information on food labels as taught by Kirk.

Furthermore, Applicants disclose that these three food safety labeling systems are notoriously well known to those of ordinary skill in the food labeling art in paragraph [0003] of the "Background of the Invention" section of Applicants' specification. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided text consisting of text found in day of the week FIFO food safety labeling systems, text relating to shelf-life/product identification food safety labeling systems and text relating to use by/use first food safety labeling systems to the label of Oosterlinck, Warther and Kirk since it is notoriously well known to provide text consisting of text used in the aforementioned food safety labeling systems as taught by the admission of Applicants.

9. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oosterlinck in view of Warther, and in further view of admitted prior art of Applicants (specification, page 1, paragraph [0003]).

Oosterlinck and Warther teach the triangular shaped label as discussed above. Oosterlinck and Warther fail to teach that printing the plurality of labels includes printing color on the plurality of labels (in regard to claim 36), that the color is related to an industry standard color code system used in food safety labeling systems and the particular colors corresponding to the days of the week in the industry standard color code system (in regard to claim 37).

However, Applicants disclose that it is notoriously well known to those of ordinary skill in the art to use the industry standard color code system used in food safety labeling systems. Afterall, the color code system is described as "industry standard" by Applicants. It would have been

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obvious to one of ordinary skill in the art at the time the invention was made to have provided color to the labels of Oosterlinck and Warther according to the industry standard color code system used in food safety labeling systems since it is notoriously well known to apply colors to labels according to the industry standard color code system used in food safety labeling systems as taught by the admission of Applicants.

10. Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oosterlinck in view of Warther, and in further view of admitted prior art of Applicants (specification, page 3, paragraph [0009]).

Oosterlinck and Warther teach the triangular shaped label as discussed above.

In regard to claim 38, Oosterlinck and Warther fail to teach that the printing on the plurality of labels further includes the step of positioning text on each of the triangular labels such that the text on each triangular label is oriented in the same direction. However, Applicants disclose that it is customary to print text on labels with a specific orientation to the shape of the label in paragraph [0009] of the "Background of the Invention" section of Applicant's specification, for instance, one accepted copy position is disclosed to be the "bottom" of the label. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have positioned text on each of the labels such that the text on each label is oriented in the same direction, since it is notoriously well known to do so as taught by the admission of Applicants.

In regard to claim 39, Oosterlinck and Warther fail to teach a variable copy position for the text which results in the text being positioned on alternating first and second sides of adjacent triangular labels. Since Applicants disclose in paragraph [0009] of the "Background of the

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Invention” section of Applicant’s specification that the labels with text in a set location on each label are often oriented in the same position on the liner so that the labels are applied with minimal handling once it is removed from the roll of labels, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have oriented the text on alternating first and second sides of the labels oriented in the arrangement taught by Warther in order to minimize the amount handling required after the labels are removed from the roll of labels prior to application of the labels since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

11. Claims 40-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over St. Aubin in view of the admitted prior art of Applicant (“Background of the Invention” section of Applicants’ specification).

In regard to claim 40, St. Aubin teaches an adhesive label comprising a triangular shaped adhesive label having a first, second and third side of equal length (equilateral triangular shaped separable portion of the label, item 29, col. 3, lines 19-21 and 35-45, col. 5, lines 12-15 and Fig. 4). St. Aubin teaches that the label includes a face material (item 15), an adhesive layer (item 26) and a liner (carrier web, item 14) (col. 2, lines 15-28 and 50-56 and Fig. 2 and 4). St. Aubin teaches that the adhesive layer entirely covers the side of the face material adjacent the liner (col. 2, lines 51-54, col. 3, lines 43-45 and Fig. 2 and 4).

St. Aubin fails to teach that the face material includes text selected from a group consisting of text found in day of the week first in first out food safety labeling systems, text relating to shelf-life/product identification food safety labeling systems and text relating to use by/use first food safety labeling systems.

However, Applicant discloses that these three food safety labeling systems are notoriously well known to those of ordinary skill in the food safety labeling art in paragraph [0003] of the "Background of the Invention" section of Applicants' specification (page 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided text consisting of text found in day of the week first in first out food safety labeling systems, text relating to shelf-life/product identification food safety labeling systems and text relating to use by/use first food safety labeling systems to the label of St. Aubin since it is notoriously well known to provide text consisting of text used in the aforementioned food safety labeling systems as taught by the admission of Applicants.

In regard to claim 41, the label of St. Aubin is necessarily removably attached to a liner (i.e. carrier web, item 14): in order to be placed onto a product, the label, item 15, which includes triangular label portion, item 29, must be removably attached to the carrier web, item 14.

In regard to claim 42, while St. Aubin does not explicitly teach the material of the face material, Applicant discloses that the face material of adhesive labels is most commonly paper, and that polyester, vinyl, polypropylene and foil are also suitable materials as the material of a face material of adhesive labels (lines 5-6 of paragraph [0005], page 2, of the "Background of the Invention" section of Applicants' specification). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used paper, polyester, vinyl, polypropylene or foil as the face material of the label of St. Aubin since paper, polyester, vinyl, polypropylene and foil are notoriously well known label face materials as taught by the admission of Applicants.

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In regard to claim 43, St. Aubin teaches that the adhesive layer is formed from a permanent adhesive (col. 3, lines 43-45).

In regard to claim 44, while St. Aubin does not explicitly teach that the liner is a silicone-coated sheet of paper, St. Aubin does teach that the liner (carrier web, item 14) has a release coating (item 25, Fig. 2) on the surface of the liner that is in contact with the adhesive layer (item 26) that is configured to allow the face material and the adhesive layer to be removed from the liner (col. 2, lines 26-28 and 50-51). Applicant discloses that a silicone-coated sheet of paper is a known adhesive label liner (lines 11-12 of paragraph [0005], page 2, of the "Background of the Invention" section of Applicants' specification). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a silicone-coated sheet of paper as the liner of St. Aubin since a silicone-coated sheet of paper is a notoriously well known label liner material as taught by the admission of Applicants.

In regard to claims 45 and 46, St. Aubin fails to teach that the printing of the plurality of labels includes printing color on the plurality of labels (in regard to claim 45) or the particular colors corresponding to the days of the week in the industry standard color code system (in regard to claim 46). However, Applicants disclose that the claimed different color for each day of the week system is an "industry standard color code system" (lines 3-7 of paragraph [0003], page 1, of the "Background of the Invention" section of Applicants' specification). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided color to the labels St. Aubin according to the industry standard color code system used in food safety labeling systems since it is notoriously well known to apply colors to labels

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according to the industry standard color code system used in food safety labeling systems as taught by the admission of Applicants.

ANSWER TO APPLICANT'S ARGUMENTS

12. Applicant's arguments regarding the 35 U.S.C. 103 rejections involving Oosterlinck and Warther presented on pages 7-9 of Amdt. E have been fully considered but are not persuasive. Applicant argues that in Applicant's process, "the facing material remains associated with the liner during the cutting process" unlike Oosterlinck's process, but this argument is irrelevant since Applicant's claims are not process claims. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113.

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Applicant argues that Warther is not analogous prior art to Applicant's field of endeavor, but as was stated on pages 9-10 of Paper 15, Warther is concerned with

maximizing the number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size (col. 3, lines 33-41) by arranging triangular-shaped labels as shown in Figures 1 and 3 of Warther. Eventhough, "Warther considers triangle shapes as difficult to remove from a scored sheet" as pointed out by Applicant, Warther nonetheless arranges triangular-shaped labels as shown in Figures 1 and 3 in order to maximize the number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size (col. 3, lines 33-41). One of ordinary skill in the art is amply motivated to combine the references to arrive at a maximum number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size as taught by Warther.

Warther is relied upon for the teaching of a particular element geometry and arrangement of these elements in order to maximize the number of elements on a sheet of a given size. Warther is not relied upon to teach the claimed label components, so Applicant's argument that tags are not labels is irrelevant. In response to Applicant's argument that there is no motivation to combine the references, one of ordinary skill in the art is amply motivated to combine the references to arrive at a maximum number of elements (such as the labels taught by Oosterlinck) provided by a sheet product of a given size as taught by Warther. Applicant's argument in the last full paragraph of page 8 of Amdt. E and in the paragraph bridging pages 8 and 9 of Amdt. E that boils down to an argument that the tags of Warther are not labels are moot because Warther is relied upon for the teaching of a particular element geometry and arrangement of these elements in order to maximize the number of elements on a sheet of a given size, not for a teaching of the claimed label components.

13. Applicant's arguments regarding St. Aubin presented on page 9 of Amdt. E have been fully considered but are not persuasive. Applicant incorrectly states that St. Aubin "does not teach or suggest a label that is in the shape of an equilateral triangle", as was stated in paragraph

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10 of Paper 15, St. Aubin teaches an embodiment in which the triangular shaped portion of the label is an equilateral triangle (col. 3, lines 19-21). Applicant states "The triangle will have two angles of from 42 to 52 degrees" as if this is a requirement of St. Aubin, but it is not a requirement, it is an example (see col. 3, lines 49-52, which starts "By way of example, not limitation"). Applicant argues that St. Aubin does not teach a label that "contains all of the information the label is meant to convey", but this argument is irrelevant since there is no requirement in the claims that the labels contain "all of the information the label is meant to convey".

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-

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1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh
10/13/04

WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
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